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PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:  
Rosenstein et al.

Application No: 09/420,918

Filed: October 20, 1999

Title: System And Method For Providing  
Base Band Voice Telephony Using  
Derived Voice Over Data Technology

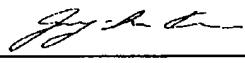
Attorney Docket No. COVDP001

Examiner: Juntima, Nittaya

Art Unit: 2663

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Signed:   
Name: Jung-hua Kuo

## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Applicant requests review of the final rejection mailed on March 29, 2005 in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheets (4 pages).

Note: No more than five (5) pages may be provided.

I am the:

attorney or agent of record. Registration Number 41,918.  
 attorney or agent acting under 37 CFR 1.34. Registration Number \_\_\_\_\_.  
 If the required fees are missing or any additional fees are required during the pendency of the subject application, please charge such fees or credit any overpayment to Deposit Account No. 50-1217 (Order No. COVDP001). A copy of this sheet is enclosed.

Respectfully submitted,



September 7, 2005

Date

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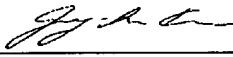
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Signed:   
Name: Jung-hua Kuo

**Reasons For Pre-Appeal Brief Request For Review**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The reasons for the Pre-Appeal Brief Request for Review are set forth below.

**The Examiner Did Not Establish a *Prima Facie* Case of Obviousness In Rejecting Claims 1-3, 5-19, and 21-24 Under 35 U.S.C. §103(a) Over Applicant's Admitted Prior Art**

Claims 1-3, 5-19, and 21-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over applicant's admitted prior art (FIG. 1). However, the Examiner did not establish a *prima facie* case of obviousness.

As the Examiner notes, FIG. 1 does not include (1) a derived voice over data termination device (that converts between base band signals and derived voice over data signals using derived voice over data technology) located outside of the client premises; (2) an analog connection that is between the client premises and the derived voice over data termination device located outside of the client premises; and (3) a DSLAM that is coupled to the derived voice over data termination device.

The Examiner contends that it would have been obvious, from FIG. 1, to modify the network of FIG. 1 to those generally described in independent claims 1, 17, and 21. However, FIG. 1 fails to provide any motivation for the varied and extensive modifications necessary to result in the system, network, and method described in independent claims 1, 17, and 21, respectively.

For example, the extensive modifications required to achieve the inventions as generally recited in independent claim 1 include: (1) locating the derived voice over data termination device outside of the client premises, such as at the Central Office; (2) providing a connection between the client premises and the derived voice over data termination device; and (3) coupling the DSLAM between the derived voice over data termination device and an ATM/FR switch or a router.

The Examiner purports that the suggestion/motivation to make such numerous and extensive modifications would have been to realize cost savings by converting the base band analog voice signals from the ADSL CPE located at the client premises 102 into derived voice over data signals (instead of forwarding the base band analog voice signals to the PSTN) and connecting to a base band analog voice port of the ADSL CPE (e.g., in a case where the ADSL CPE does not have enough derived voice over data ports to support an additional derived voice over data connection).

However, the VO-ATM CPE 110 in configuration of FIG. 1 generally provides several voice ports, thus allowing several different telephone numbers (or lines or connections) to be supported using a single VO-ATM CPE 110. A typical customer either has more than a sufficient number of ports or needs many more ports (rather than one more port). Even if a particular customer currently desires or needs *exactly one* additional derived voice over data connection, this customer would likely have changing needs over time (e.g., he or she would need additional ports) such that the customer would likely desire a VO-ATM CPE 110 with additional derived voice over data ports or another VO-ATM CPE 110. It is well known that the cost of providing additional voice ports is generally insignificant, at least when compared to the modifications suggested by the Examiner. In other words, a customer having a need for several derived voice over data connections rarely needs (or desires to be limited to) exactly one

additional derived voice over data connection but rather would need the ability to scale his or her telephone system.

As noted, the Examiner also states that providing cost savings on call connections to a customer having the existing ADSL CPE unit is part of the motivation to modify the network of FIG. 1. However, the ADSL CPE already provides several derived voice over data ports, which in turn provide cost savings on call connections to the customer. As such, providing a single additional derived voice over data connection that is so differently configured from (a) the derived voice over data configuration that the customer already has and (b) the configuration that the provider already provides would result in cost increases, not cost savings. In other words, providing a single derived voice over data connection using a completely different configuration (versus simply providing additional derived voice over data ports using the same configuration as shown in FIG. 1) would not result in cost savings, but rather, in cost increases. Thus there would be no cost savings to the customer as motivation to modify the network of FIG. 1.

In contrast, the configuration as claimed enables a customer to subscribe to voice over data technology without having voice over data equipment at the client premises and without having a voice over data line between the client premises 302b and the central office. In other words, the local loop between the client premises 302b and the central office 304 can remain an analog or base band loop 318b as shown in FIG. 3. The customer thus may subscribe to voice over data connection even if the loop between the client premises and the central office would not qualify for DSL services (e.g., if the client premises is too far from the central office to receive DSL service).

The Examiner did not establish a *prima facie* case of obviousness. To establish a *prima facie* evidence of obviousness, the prior art, alone or combined with other references, must have rendered the invention obvious to one of ordinary skill in the art at the time of invention. *Al-Site Corp. v. VSI International Inc.*, 174 F.3d 1308 at 1323, 50 USPQ2d 1161 (Fed. Cir. 1999, emphasis added). See also MPEP § 2143. Here, there is no objective evidence that the modifications of FIG. 1 necessary to achieve the claimed invention would have been obvious to one skilled in the art at the time of the invention. Instead, Applicants submit that the Examiner

has incorrectly relied upon hindsight, based on the application itself, to provide the suggestion to modify the network of FIG. 1.

Moreover, the mere fact that the reference can be modified does not render the resultant modified system obvious unless the prior art suggests the desirability of the combination or modification. *In re Mills*, 915 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); *see also, Al-Site*, 174 F.3d at 1323-1324 (must show “some motivation or suggestion to combine the prior art teachings”). In this case, FIG. 1 does not suggest the modifications necessary to result in the presently claimed inventions.

In view of the foregoing, FIG. 1 does not make the presently claimed inventions obvious under 35 USC §103. Withdrawal of the rejection of claims 1-3, 5-16 and 21-24 under 35 U.S.C. §103(a) is respectfully requested.

#### Conclusion

Because the Examiner’s rejections of claims 1-3, 5-19, and 21-24 includes legal deficiencies with regard to under 35 U.S.C. § 103(a) and the MPEP, Applicants are entitled to a pre-appeal brief review of the final rejection. And based on the foregoing arguments, Applicants request that the rejection of these claims be withdrawn and the pending claims be allowed.

If the required fees are missing or any additional fees are required during the pendency of the subject application, please charge such fees or credit any overpayment to Deposit Account No. 50-1217 (Order No. COVDP001).

Respectfully submitted,



September 7, 2005

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